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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/733,125

12/11/2003

Robert Winegard

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7590

06/06/2008

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EXAMINER

CURS, NATHAN M

ART UNIT

PAPER NUMBER

2613

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/733,125	<b>Applicant(s)</b> WINEGARD, ROBERT	
	<b>Examiner</b> NATHAN M. CURS	<b>Art Unit</b> 2613	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7 is/are allowed.
- 6) ☒ Claim(s) 8-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Cline (US Patent No. 4903298).

Regarding claim 11, Cline discloses a secure/non-secure bypass switch, comprising: a secure mode signal path (fig. 6, elements 221, 211, 210 and 321 and col. 7 line 29 to col. 8 line 2) and a non-secure mode signal path (fig. 6, elements 320, 210 and 321 and col. 7 line 29 to col. 8 line 2); wherein signals are routed through an encryption device connected in the secure mode signal path when no power is supplied to the switch, and the signals are routed through the non-secure path when power is supplied to the switch (col. 13 lines 37-66).

Regarding claim 12, Claim discloses a secure/non-secure signal bypass method in a secure/non-secure bypass switch having a secure path (fig. 6, elements 221, 211, 210 and 321 and col. 7 line 29 to col. 8 line 2) and a non-secure path (fig. 6, elements 320, 210 and 321 and col. 7 line 29 to col. 8 line 2), comprising the steps of: when no power is supplied to the secure/non-secure bypass switch, routing signals through the secure path and when power is supplied to the secure/non-secure bypass switch, routing signals through the non-secure path (col. 13 lines 37-66).

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 8-12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of copending Application No. 11/140209.

Although the conflicting claims are not identical, they are not patentably distinct from each other.

Regarding claim 8, 11/140209 claims a method of secure/non-secure switching in a secure/non-secure bypass switch, comprising the steps of: receiving signals to be routed; determining if a secure or a non-secure operating mode is selected; if a non-secure mode is selected, configuring at least one relay to route the signals through at least two fiber optic modems to an output port; and if a secure mode is selected, configuring at least one relay to route the signals through an external encryption device to said output port (Claim 7). 11/140209 claims “at least one relay” instead of “relays”; however, the language “at least one” suggests the possibility of more than one. One of ordinary skill in the art at the time of the invention could have used two or more relays to route the signals, with a relay corresponding to each input/output side of the modems/encryption device and the results would have been predictable,

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namely, switching control of the signaling at both the input side and output side of the switching paths.

Regarding claim 9, 11/140209 claims the method of Claim 8, wherein if no power is supplied to the bypass switch the secure mode is selected (claim 7).

Regarding claim 10, 11/140209 claims the method of Claim 9, further comprising the step of disconnecting power to the fiber optic modems in the secure mode (claim 9).

Regarding claim 11, 11/140209 claims a secure/non-secure bypass switch, comprising: a secure mode signal path; and a non-secure mode signal path, wherein signals are routed through an encryption device connected in the secure mode signal path when no power is supplied to the switch, and the signals are routed through the non-secure path when power is supplied to the switch (claim 15).

Regarding claim 12, 11/140209 claims a secure/non-secure signal bypass method in a secure/non-secure bypass switch having a secure path and a non-secure path, comprising the steps of: when no power is supplied to the secure/non-secure bypass switch, routing signals through the secure path; and when power is supplied to the secure/non-secure bypass switch, routing signals through the non-secure path (claim 15).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***Allowable Subject Matter***

5. Claims 1-7 are allowed.

#### ***Response to Arguments***

6. Applicant's arguments filed 15 February 2008, with respect to claim 8-12 have been fully considered but they are not fully persuasive.

In the Remarks page 7 line 17 to page 8 line 2, the Applicant argues that Cline does not teach or disclose that signals are routed through two switch states depending on whether or not power is supplied to the switch. However, the relays of Cline are switched between their two switch states by either energized or unenergized (see fig. 6 and col. 13 lines 37-66); this reads on routing signals through two switch states depending on whether or not power is supplied to the switch.

In the Remarks page 10 lines 3-11, the Applicant "reserves the right to address" the provisional ODP rejections of claim 8-12 "when all of the remaining issues are resolved", and then asserts that independent claims 8, 11, 12 are believed to be in condition for allowance. This argument is not persuasive because the ODP rejections remain.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Conclusion***

8. Any inquiry concerning this communication from the examiner should be directed to N. Curs whose telephone number is (571) 272-3028. The examiner can normally be reached on M-F (from 9 AM to 5 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Chan, can be reached at (571) 272-3022. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pairedirect.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/N. M. C./

Examiner, Art Unit 2613

/Jason Chan/

Supervisory Patent Examiner, Art Unit 2613